UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,152	07/15/2003	Alfred Thomas	47079-00219	1210

30223 7590 04/02/2007

JENKENS & GILCHRIST, P.C.
225 WEST WASHINGTON
SUITE 2600
CHICAGO, IL 60606

EXAMINER	
LEIVA, FRANK M	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/621,152	THOMAS, ALFRED	
	Examiner	Art Unit	
	Frank M. Leiva	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08/08/2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in responsive to the amendments filed 08/08/2006.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 5-8, 20, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. (US Patent No. 6,491,584 B2), hereinafter Graham, in view of Bennett (US Patent No. 6,056,642), hereinafter Bennett.

4. **Graham teaches** a video slot machine that contains multiple trigger events with bonus features. It is further taught that there is a video display unit 14 that simulates the rotation of a number of spinning reels 18 (col. 2: 41-44) in a base game that receives a wager and utilizes the mechanical device, such as a video slot reel (Fig. 2: ref. 24.1, 24.2; col. 2: 39-48) [claims 1, 2, 7, 20, 30]. The game machine detects an indication, or triggering condition, to play a special feature game that utilizes the mechanical device (col. 1: 29-49) [claims 1, 20, 30], where the triggering condition gives free games to the player and upon a second triggering condition there are more free games and a bonus feature awarded. This is inherent to be a bonus game where there are extra awards available [claim 3]. **Graham lacks** in specifically disclosing a response to the triggering condition that changes the appearance of the mechanical device and mechanical spinning reels. However, **Bennett teaches** a winning condition such as taught by Graham as a triggering condition detected from a predefined result on mechanical spinning reels [claim 8, 31], where the winning condition is also a predefined set, such as three 7s (See Bennett, col. 2: 42-44) [claims 1, 2, 30]. Further, the change in appearance based on the winning condition or triggering event comprises an illumination by backlighting from an illumination source of the gaming machine

[claims 1, 5, 20, 30], wherein the illumination source is comprised of LEDs for display (col. 2: 47-52) [claim 6]. The 7s change color by the illumination source when the winning condition is met and therefore the appearance of the mechanical device is changed [claims 1, 30] and alerts the player that the winning condition has been met, which creates visual stimulation and excitement for the player; thus it would have been obvious to one of ordinary skill in the art to change the appearance of the mechanical device upon a winning condition detected. It is also inherent that the displayed mechanical device is operable during both the base game and special feature game. Additional inherency lies in the gaming machine containing a controller that is operatively coupled to the value input device, displayed mechanical device and the illumination source (See Graham, col. 2: 54 – col. 3: 4). It would have been obvious to one of ordinary skill in the art to introduce the optical stimulation of lights and color of Bennett in the invention of graham in order to give the player excitement during the players gaming experience, and to enhance the visibility of play of the physical reels over the Video Slot games competing on the floor for attention.

5. **Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graham, in view of Bennett, as applied to the above limitations, and further in view of applicants own admissions.**

6. **Claim 1** limitation "to provide visual notification to a player that the special feature game is underway", is rejected under applicants own admission in the specifications page 8 ¶[0017] that reads, "*the invention is compliance with gaming regulations requiring visual notification to a player when he/she moves from base game play to special feature game play and from special feature game play",* meaning that it is well known in the art to have this feature in all gaming devices.

7. **Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graham, in view of Bennett, as applied to the above limitations, and in further view of Perrie et al. (US Patent No. 6,481,713 B2), hereinafter Perrie**.

8. **Claim 30** limitations regarding the math of the paytables for the base game and the bonus game being different, are taught by Bennett by using a multiplier to the base game paytable, thus changing the math, but is also mentioned in Perrie (col.22: 35-40) where it states that this dice game can be added to any base game as a bonus game. Thus reels versus dice game would have distinct odds calculations and the motivation to combined is explicitly stated in the writings of Perrie and one of ordinary skill in the art could easily combined the teachings to add a substantially different game to a base game to make it more interesting to the player.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graham, in view of Cannon (US 2002/0025845 A1), hereinafter Cannon.

10. **Regarding claim 4**, Graham lacks in disclosing that the special feature game comprises a secondary game with an additional wager. Cannon teaches a dual wagering game where the player wagers on both a base game and a bonus game. The bonus game determines a multiplier that applies to the results of the base game winnings. It would have been obvious to one of ordinary skill in the art to use a secondary game such as the bonus game taught by Cannon (Abstract) in order to receive more money from the player, but also benefit the player with a possibility of increasing winnings through the multiplier value [claim 4]. Cannon teaches that the multiplier is used with the base game and is therefore directly applicable to being used with the base game of Graham because they are both slot machines.

11. **Claims 9 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham, in view of Bennett, and further in view of Perrie**.

12. **Graham teaches** a video slot machine with a trigger condition while Bennett teaches a slot machine that changes appearance upon winning condition, which is inherently a triggering condition for bonus games in many slot machines. Perrie teaches where the mechanical device is comprised of mechanical dice (col. 7: 14-26). It would have been obvious to one of ordinary skill in the art to contain mechanical dice in the game system in order to diversify a game such as poker. By creating a newer game, the game machine

becomes interesting to new patrons because of a different version of the most common game in gambling. Moreover, having dice set up as they are in Figure 5 of Perrie shows that it performs equally well as a slot device because the each die spins in the same place that a reel would be. Both have symbols located on them and generate outcomes.

13. **Claims 10 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham, in view of Bennett, and further in view of Perrie.**

14. **Graham teaches** a video slot machine with a trigger condition while Bennett teaches a slot machine that changes appearance upon winning condition, which is inherently a triggering condition for bonus games in many slot machines. It would have been obvious to one of ordinary skill in the art for the mechanical device to be a wheel because a wheel would perform equally well with respect to a reel. Both generate outcomes from the indicia located on them. One would be able to put symbols for the game on a wheel and the reel and create random outcomes. Both are capable of containing triggering events to move to bonus games. Therefore, it would be a mere design choice to have a wheel or a reel because the outcome of the game would end up being the same and the choice of one over the other does not solve any stated problem.

15. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. (US Patent No. 6,491,584 B2), hereinafter Graham, in view of Gauselmann (US 2004/0092299 A1).

16. **Graham teaches** a video slot machine that contains multiple trigger events with bonus features. However, Graham lacks in specifically disclosing that there is an indication of a bonus feature as chosen by the player. Gauselmann teaches players choosing special symbols during a base game that may be used as a variety of things, such as a bonus game trigger symbol (¶ 0004) [claims 11, 12]. It would have been obvious to one of ordinary skill in the art to allow a player to customize the bonus trigger event to increase user interaction, in turn increasing user excitement to generate more revenue by the gaming machine.

17. Claims 13-17, and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. (US Patent No. 6,491,584 B2), hereinafter Graham, in view of Bennett (US Patent No. 6,056,642) in further view of Webb (US Patent No. 6,843,722).

18. **Graham teaches** a video slot machine that contains multiple trigger events with bonus features. It is further taught that there is a video display unit 14 that simulates the rotation of a number of spinning reels 18 (col. 2: 41-44) in a base game that receives a wager and utilizes the mechanical device, such as a video slot reel (col. 2: 39-48) [claims 17, 13, 26]. The game machine detects an indication, or triggering condition, to play a special feature game that utilizes the mechanical device (col. 1: 29-49) [claim 13], where the triggering condition gives free games to the player and upon a second triggering condition there are more free games and a bonus feature awarded. This is inherent to be a bonus game where there are extra awards available. Graham lacks in specifically disclosing a response to the triggering condition that changes the appearance of the mechanical device and mechanical spinning reels. However, Bennett teaches a winning condition such as taught by Graham as a triggering condition detected from a predefined result on mechanical spinning reels [claim 27], where the winning condition is also a predefined set, such as three 7s (See Bennett, col. 2: 42-44) [claims 13, 26]. Further, the change in appearance based on the winning condition or triggering event comprises an illumination by backlighting from an illumination source of the gaming machine [claims 14, 13, 23], wherein the illumination source is comprised of LEDs for display (col. 2: 47-52) [claims 15, 22]. The 7s change color by the illumination source when the winning condition is met [claim 23] and therefore the appearance of the mechanical device is changed and alerts the player that the winning condition has been met, which creates visual stimulation and excitement for the player; thus it would have been obvious to one of ordinary skill in the art to change the appearance of the mechanical device upon a winning condition detected. Graham lacks in specifically disclosing that after the triggering event indicates for a special feature game that the special feature game is ended by a terminating indication (i.e., second indication). Webb teaches a bonus game that contains a terminator symbol within the selections of the bonus game [claims 13, 21]. It would have been obvious to one of ordinary skill in the art to employ a terminating event in

any bonus game so that there is no way of allowing the player to play the bonus game indefinitely. This would have a negative effect on the casino and the gaming company who sells the gaming machines. It should be made of note that a terminator indication may be taken as a simple loss in the bonus game. So, assuming a basic bonus game with one chance to increase profits, if a player plays and loses, then that could be taken as a terminating indicator to end the bonus game. It is further noted that bonus games are common to light up to show the difference between the basic game and bonus game. With the entrance of the bonus game through a winning combination as taught by Bennett (col. 2: 41-44), it would have been obvious to one of ordinary skill in the art that when a bonus game has ended that the change in appearance, such as lights turning off or dimming down, would be implemented in order to indicate the bonus game has ended and the player is back to the basic game [claim 13, 16, 21]. Moreover, it would be obvious to one of ordinary skill in the art that such an end to a bonus game would be indicated by the terminating indicator taught by Webb so that the game machine has an electrical indication of the game ending.

19. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al. (US Patent No. 6,491,584 B2), hereinafter Graham, in view of Gauselmann (US 2004/0092299 A1) in further view of Webb (US Patent No. 6,843,722 B2).

Graham teaches a video slot machine that contains multiple trigger events with bonus features. However, Graham lacks in specifically disclosing that there is an indication of a bonus feature and termination feature as chosen by the player. Gauselmann teaches players choosing special symbols during a base game that may be used as a variety of things, such as a bonus game trigger symbol (¶ 0004) [18, 19]. It would have been obvious to one of ordinary skill in the art to allow a player to customize the bonus trigger event to increase user interaction, in turn increasing user excitement to generate more revenue by the gaming machine. Further, Webb teaches a bonus game that contains a terminator symbol within the selections of the bonus game, which would be the second indicator [claim 18]. It would have been obvious to one of ordinary skill in the art to employ a terminating event in any bonus game so that there is no way of allowing the player to play the bonus game indefinitely. This would have a negative effect on the casino and the gaming company who sells the gaming

machines. It should be made of note that a terminator indication may be taken as a simple loss in the bonus game. So, assuming a basic bonus game with one chance to increase profits, if a player plays and loses, then that could be taken as a terminating indicator to end the bonus game.

Response to Arguments

20. **Applicant's arguments filed 08/08/2006 have been fully considered but they are not persuasive**. Argument will be answer in sequential order as follow;
To the argument directed to "*The Office Action does not refer to any motivation or suggestion to combine the two references*", the examiner accepts that the statement is missing and it has been corrected in this office action. As for the use of the teachings of a mechanical reel being combine with the teachings of a video slot machine is obvious by the applicants own admission in claim 2 of the present invention, "*The method for changing the appearance of the mechanical device of claim 1, wherein the base wagering game is selected from the group consisting of mechanical slots, video slots, video poker, video blackjack, video keno and video bingo*", where the applicant expresses that these games are of analogous art and the teachings are applicable to all these games.
21. To the argument directed to "*Bennett '642 does not disclose a special feature game or changing the color of the mechanical reels when an indication to detect a special feature game is received. In fact the function of the change in color in Bennett '642 is to enhance the base game, not to indicate a change in games*", the examiner does not find this limitation in the claim language, yet since the argument has been raised, if claims 1 and 5 were written in independent form to read as such, please read Iwamoto (US 7,070,504) which will be cited for record.

22. To the argument stating, "*Claim 1 includes the limitations of "a base wagering game that utilizes a mechanical device" and "a special feature game that utilizes the*

mechanical device." There is no disclosure in either Graham or Bennett '642 of utilizing the same mechanical device to play both a base game and a special feature game", it has been mentions above in section 20, that Claim 2 admits to the mechanical reels are the same in operation as video reels for the implementation of the present invention.

23. The argument concerning the amendment to claim 1 is moot in view of new grounds of rejection.

24. The argument concerning claims 20 and 30 are not persuasive for the reasons stated above in reference to Claim 1. Furthermore, the arguments concerning the amendments to Claim 30 are moot due to new grounds of rejection.

25. The argument concerning Claim 13 rejection, stating that the teaching of Bennett would not light up or change colors is traverse. The examiner clearly sees the invention of Bennett lighting up symbols and combinations, which would indicate a winning hand as well as, any combination of symbols that would start a bonus round. It is well known in the art and also admitted prior art that gaming machines must show or point out the combinations that gave rise to the bonus round prior to changing over to the bonus mode.

26. The argument concerning Webb's teaching of the restoration of colors, is inherent in the teaching since is well known in the art than when returning back to regular game play the display will reset all values back to game play state. Any color changes performed during the bonus round would automatically change back as to not confuse the player. This would be obvious to one of ordinary skill in the art.

27. Claims 4, 9-12, 18, 19, and 21-29, are dependent from claims 1, 13, and 20, and all references as applied above to all limitations, the claims are still rejected.

Citation of Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker et al (US 2004/0242297 A1) discloses announcement of a bonus mode. Suzuki (US 2003/0013511 A1) discloses announcement of a bonus round. Iwamoto (7,070,504) discloses the annou8ncement of a bonus mode.

Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Leiva whose telephone number is (571) 272-2460. The examiner can normally be reached on M-Th 8:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML
03/17/2007

Robert E Pezzuto
Supervisory Patent Examiner
Art Unit 3714